1761 #

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : van Lengerich

Serial No. : 09/233,443 Group Art Unit: 1761

Filed : January 20, 1999 Examiner: Mr. Edward Webman

For : ENCAPSULATION OF SENSITIVE LIQUID COMPONENTS INTO A MATRIX TO OBTAIN DISCRETE SHELF-STABLE PARTICLES

#11
10/26/00

ELECTION, RESPONSE TO RESTRICTION REQUIREMENT AND RECORD OF TELEPHONIC INTERVIEW WITH THE EXAMINER

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

Responsive to the September 07, 2000 election and restriction requirement, the applicant hereby elects the invention of Group I, claims 21-27 and 46-67, durum wheat plasticizable matrix species and enzyme "~~neutraceutical~~" species, **with traverse**.

Applicant believes that claims 21-22, 25-29, 46-64 and 66-67 are readable upon the durum wheat plasticizable matrix species. Applicant further believes that claims 21-24, 26-29 and 46-55 and 57-67 are readable on the enzyme neutraceutical species.

In a telephonic interview that occurred September 07, 2000 between Examiner Webman and Mr. Andrew Merriam, Representing Applicants, Mr. Merriam indicated that the two-part restriction requirement does not define two products that are mutually exclusive species, and so the restriction requirement between two groups is improperly based on the intermediate-final prod t relationship. The Examiner agreed to reconsider

the restriction requirement. The Examiner stated that there are other products falling within the scope of the present claims other than food products. Mr. Merriam agreed, stated however that claim 21 and claim 28 comprise the same encapsulated product, with the difference between the two lying only in the admixture of the encapsulated product in a food product in claim 28. Thus, if any restriction were to be made between these claims, this restriction should comprise at most a species election.

The applicant traverses the two-part restriction requiring an election between the "inventive group" of an encapsulated product and the "inventive group" of a food product because these two groups of claims do not define a mutually exclusive species of invention, as is required to make a restriction based on the intermediate-final product relationship. See MPEP § 806.04(b) and (f). Applying the definition of a "mutually exclusive species relationship," there is no element recited in the first group or "intermediate" product claims which is not found in the second group or "final product"claims; and there is no element found in the second group or "final product" claims which is disclosed by the specification only for this second group of claims and not for the first group of claims. MPEP 806.04(f). The "mutually exclusive species" requirement is definitional, meaning that the restriction requirement proposed is improper. Moreover, looking at what inventive "Groups" I and II have in common, both the first and second group of claims recite limitations to the same encapsulant, the same plasticizable matrix, the same liquid plasticizer component, and the same encapsulated

product. So both groups of claims define the same essential characteristics of the single disclosed embodiment of the presently claimed invention. This means that restriction between these groups of claims should never be required. See MPEP § 806.02. Finally, there is an overlap in utility of the two groups of invention, the first group of claims reciting a product which is edible, as seen in claims 46 and 61-65, and which includes within its scope the product of the second group of claims. So, a search of the invention of the first group of claims would encompass a food art search, which is the class 426 search of the second group of claims.

The applicant traverses all of the requirements for an election of species because a search of any one species of plasticizable matrix material would encompass the same search as would a search of the remainder of all plasticizable matrix material species, requiring a search in the food art of class 426, as well as the microcapsule art of classes 424 and 428 and the polysaccharide art of class 536. Likewise, the search for each nutraceutical species of nutraceutical encapsulants is coextensive with a search for all other nutraceutical species in the food and microcapsule arts, with the remainder of the search comprising microcapsule and polysaccharide arts. Finally, a search of the edible product of claims 46 and 61-65 would encompass the same subject matter as a search of each species of "food products." Thus, withdrawal of the species election requirements should not impose a serious burden on the Examiner versus a complete search of any one set of species, and applicant believes that such election requirements should be

withdrawn. See MPEP § 803.

Also, the Examiner's position that during patent prosecution, process limitations in product claims are not considered as patentable limitations is untenable. It is well established that a product can be defined by its method of manufacture and that process limitations can affect and define a product's attributes or properties. Reconsideration and withdrawal of the March 5, 2000 restriction requirement is again respectfully requested.

Submitted concurrently herewith is a petition requesting a one-month extension and the accompanying fee of $110.00 to maintain the pendency of the instant file.

If any additional fees are due, please charge our Deposit Account No. 50-1032.

Respectfully submitted,

Barry I. Hollander
Registration No. 28,566

Hollander Law Firm, P.L.C.
10300 Eaton Place, Suite 305
Fairfax, VA 22030
(703) 383-4800

October 6, 2000

CERTIFICATE OF MAILING

I hereby certify that this correspondence dated 10/6/00 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on 10/6/00.

HOLLANDER LAW FIRM, P.L.C.
Suite 305
10300 Eaton Place
Fairfax, Virginia 22030

Date: 10/6/00